

**REMARKS**

Upon entry of the instant amendment, claims 13-30 will remain pending in the instant application and stand ready for further action on the merits. Newly added claims 13-30 do not incorporate new matter into the application as originally filed and find full 35 USC § 112 support in the originally filed application.

In newly added claims there is recited a process for producing a modified particle (A) (see claims 13-16), a process for producing a catalyst component for addition polymerization (see claims 17-20), a process for producing a catalyst for addition polymerization (see claims 21-24), and a process for producing an addition polymer (see claims 25-30).

***Earlier filed 37 CFR §1.132 Declaration***

With applicant's prior response of June 13, 2005, there was enclosed a 37 CFR § 1.132 Declaration of Mr. Kazuo TAKAOKI, the instant inventor. The Examiner is respectfully requested to again review Mr. TAKAOKI's declaration at this time, as it is submitted to be material to a consideration of the patentability of instantly pending claims 13-30. In this regard, the Patent Office should consider all rebuttal arguments and evidence presented by applicants, *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

Further, rebuttal evidence and arguments can be presented in the specification, *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687, by counsel, *In re Chu*, 66 F.3d 292, 299, 36 USPQ2d 1089, 1094-95 (Fed. Cir. 1995), or by way of an affidavit or declaration under 37 CFR § 1.132, e.g., *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687; *In re Piasecki*, 745 F.2d 1468, 1474, 223 USPQ 785, 789-90 (Fed. Cir. 1984).

***Claim Rejections – 35 USC § 102(a)/102(e)***

Claims 1-12 have been rejected under the provisions of 35 USC § 102(e) as being anticipated by Ogane US 2002/0143124 (US '124). Claims 1-12 have also been rejected under the provisions of 35 USC § 102(a) as being anticipated by Ogane DE 101 64 188 (DE '188). Reconsideration and withdraw of each of these rejections is respectfully requested based on the following considerations.

*Anticipation – Legal Standard*

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

*Distinctions Over Ogane US '124*

The present fundamental process claims (claim 13 or 17) are directed to a process containing a step consisting essentially of contacting:

- (i) a compound represented by the formula  $\text{BiL}^1_m$ ,
- (ii) a compound represented by the formula  $\text{R}^1_{t-n}\text{TH}_n$ , and
- (iii) a particle.

In contrast to the present invention, the cited prior art of Ogane US '124 discloses a process comprising the step of contacting:

- (i) a compound represented by the formula  $M^1L^1_m$ ,
- (ii) a compound represented by the formula  $R^1_{t-1}TH$ ,
- (iii) a compound represented by the formula  $R^2_{t-2}TH_2$ , and
- (iv) a particle.

As such, it is submitted that the cited Ogane US '124 reference is incapable of anticipating the present invention as claimed, since it fails to teach or provide for each of the limitations as instantly recited in pending process claims 13-30.

In order to facilitate the Examiner's comparison of the present invention with the teachings and disclosure of the cited art of Ogane US '124, the following table A is provided.

**TABLE A**

Present Invention	Ogane US '124	Comparison
(i) $BiL^1_m$	(i) $M^1L^1_m$	Same as each other
(ii) $R^1_{t-n}TH_n$	(ii) $R^1_{t-1}TH$	Same as each other
(iii) particle	(iv) particle	Same as each other
-----	(iii) $R^2_{t-2}TH_2$	<u>See the following</u>

As shown in the above **TABLE A**, the cited Ogane US '124 reference always requires the presence of an  $R^2_{t-2}TH_2$  component, which is not part of the present invention as claimed, and which is

excluded from the recited process step in each of newly presented claims 13 and 17 of the present invention, by the use of the limiting transitional phrase “consisting essentially of” in each of claims 13 and 17.

More generally, regarding the use of  $R^2_{t-2}TH_2$ , as taught in Ogane US ‘124, the present specification as filed does not mention the same and the presently pending claims likewise exclude the same in their recited process steps (e.g., see claims 13 and 17), since it is not part of the present invention.

Indeed, if  $R^2_{t-2}TH_2$  is included in the present invention, there cannot be obtained a catalyst having a high polymerization activity. This is clearly shown in the earlier submitted 37 CFR § 1.132 declaration of Mr. Takaoki, which was filed in the matter of the instant application on June 13, 2005.

More specifically, in Table 1 of Mr. Takaoki’s 37 CFR § 1.132 Declaration (*see page 6 thereof*) it is shown as follows:

**Example 2**  
(Inventive Example)

- Using no  $R^2_{t-2}TH_2$  had a polymerization activity of 3,500;

**Experiment 1**  
(Comparative Example)

- Using water ( $H_2O$  as  $R^2_{t-2}TH_2$ ,  $Bi/H_2O = 1/1$  by mole) had a polymerization activity of 2,634, which is smaller than that obtained in Example 2 (i.e., 3,500); and

**Experiment 2**  
(Comparative Example)

- Using a smaller amount of water ( $H_2O$  as  $R^2_{t-2}TH_2$ ,  $Bi/H_2O = 1/0.25$  by mole) had a polymerization activity of 2,308, which is much smaller than that obtained in Example 2 (i.e., 3,500).

Accordingly, such facts of distinction, and such comparative test results show that the present invention as claimed is not anticipated or rendered obvious by the cited Ogane US ‘124 reference of record.

Distinctions Over Ogane DE '188

Since DE 101 64 188 A1 is a counter-part of US 2002/0143124, it also follows that the instantly claimed invention is not anticipated by DE 101 64 188 A1 in view of the reasons described above, and is further not rendered obvious thereby. For example, DE 101 64 188 A1 does not provide any motivation to those of ordinary skill in the art to exclude its  $R^2_{t-2}TH_2$  component, such as water.

CONCLUSION

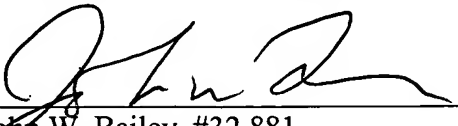
Based on the remarks submitted herein, and the comparative testing set forth in Mr. TAKAOKI's earlier filed 37 CFR § 1.132 Declaration, the Examiner is respectfully requested to reconsider and withdraw each of the outstanding rejections of record, and to issue a Notice of Allowance, clearly indicating that each of pending claims 13-30 is allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By   
John W. Bailey, #32,881

JWB:jwb

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000